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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,211	12/12/2000	Pasi Lahtinen	2132-42PCON	4277

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EXAMINER

IQBAL, KHAWAR

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/735,211

Applicant(s)

LAHTINEN, PASI

Examiner

Khawar Iqbal

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3-21-05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 10 and 11, the newly added claimed limitations "wherein the call-back connection setup message does not include billing information and said step of identifying a subscription of the A-party is in response to the call-back connection setup message" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2,5-7 are rejected under 35 U.S.C. 102(e) as being unpatentable by Merchant (WO 9719548).

5. Regarding claim 1 Merchant teaches a method for setting up a call- back connection between an A-party located in a first country and a B-party located in a second country using a switched telecommunication system that includes a switched telecommunication network comprising a digital mobile telecommunications network, a telecommunication terminal of the A-party and connected to the switched telecommunication network, a telecommunication terminal of the B-party and connected to the switched telecommunication network, and a telecommunication server connected to the switched telecommunication network and comprising means for handling messages and setting up telecommunication connections, comprising the steps of ( figs. 1-2):

sending, from the A-party telecommunication terminal to the telecommunication server, a call setup message using the switched telecommunication network and

without establishing a telecommunication connection between the A-party telecommunication terminal and the telecommunication server (page # 5, lines 16-23);

identifying, at the telecommunication server, a subscription of the A-party (page 5, lines 16-23);

setting up, at the telecommunication server, a first telecommunication connection from the telecommunication server to the A-party telecommunication terminal (page 5, lines 16-30);

setting up, at the telecommunication server based on the call setup message received from the A-party telecommunication terminal, a second telecommunication connection from the telecommunication server to the B-party telecommunication terminal (page 5, lines 16-30); and

connecting together, at the telecommunication server, the first and second telecommunication connections to establish a telecommunication connection from the B-party telecommunication terminal to the A-party telecommunication terminal (page 5, line 16-page line 4);

directing, to the A-party subscription, call charges for the telecommunication connection from the B-party telecommunication terminal to the A-party telecommunication terminal (page 6, lines 1-9).

Regarding claims 2 and 7 Merchant teaches wherein the call setup message contains a telephone number of the B-party (page 6, lines 5-21).

Regarding claims 5,6 Merchant teaches a system for setting up a telecommunication connection between an A-party located in a first country and a B-

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party located in a second country using a switched telecommunication system that includes a switched telecommunication network comprising a digital mobile telecommunications network, a telecommunication terminal of the A-party and connected to the switched telecommunication network, and a telecommunication terminal of the B-party and connected to the switched telecommunication network, the system comprising (figs. 1-2):

a telecommunication server connected to the switched telecommunication network and operable for handling messages and setting up telecommunication connections (page 5, line 16-page line 4), said server comprising means for identifying a subscription of the B-party from a call setup message received by said server from the A-party telecommunication terminal (page 5, line 16-page line 4), means for setting up a first telecommunication connection from the server to the A-party telecommunication terminal and a second telecommunication connection from the server to the B-party telecommunication terminal based on the call setup message (page 5, line 16-page line 4), and means for connecting the first and second telecommunication connections to establish a telecommunication connection from the B-party telecommunication terminal to the A-party telecommunication terminal (page 6, lines 1-9).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merchant (WO 9719548) further in view of Joensuu et al (5966653).

Regarding claims 4,9 Merchant does not specifically teach USSD messages

In an analogous art, Joensuu et al teaches USSD messages (col. 5, lines 33-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Merchant by specifically adding feature USSD messages in order to enhance purpose of increasing efficiency as taught by Joensuu et al.

#### Response to Arguments

Applicant's arguments filed 3-21-05 have been fully considered but they are not persuasive. Examiner has thoroughly reviewed applicant's arguments but firmly believes the cited reference to reasonably and properly meets the claimed limitations. Applicant's argument was that "a call setup message using the switched telecommunication network". In response, examiner would like to point out that Merchant teaches callback center 110 is a specialized switching center and call back center 110 determines the finite resources of a switch(s) connected processor is capable of handling the callback request. Additionally, the examiner has given the claim language its broadest reasonable interpretation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is "inherent" or otherwise implicit in relevant reference (*Standard Havens products Incorporated v. Gencor Industries Incorporated*, 21 USPQ2d 1321).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Khawar Iqbal whose telephone number is (571) 272-7909.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone




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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Khawar Iqbal*

  
**RAFAEL PEREZ-GUTIERREZ**  
**PATENT EXAMINER**  
5/11/05